



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/973,411 | 10/09/2001 | William Scott Caldwell | T103 1300.4 | 7174 |

7590 09/04/2002

Carl B. Massey, Jr.
Womble Carlyle Sandridge & Rice, PLLC
Post Office Box 7037
Atlanta, GA 30357-0037

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/04/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/973,411 | CALDWELL ET AL. |
| | Examiner | Art Unit |
| | Venkataraman Balasubramanian | 1624 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 June 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
- Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Applicants' response along with a declaration from Dr. William Caldwell filed on 6/12/2002 is made of record.

Claim 12 is pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dull et al. US 5,597,919 for reasons of record. To repeat:

Dull et al. teaches several pyrimidinyl and pyridinyl substituted olefinic amines claimed herein for the treatment of central nervous disorders. See formula shown on col. 5 and note the definition of A, A', A", X, X', E', E", Z', Z" groups and value of m, n, p shown on col. Note some species are shown as cis and trans forms (i.e. present as Z and E forms). See col. 14-18 for process of making these compounds.

While said compound doesn't anticipate the scope of claim 12, they are very closely related, being homologs of compounds i.e. instant pentene (i.e. methyl-butene) vs butene of the reference. However, homologs and compounds that differ only by CH₃ Vs H are not deemed patentably distinct absent evidence of superior or unexpected properties. See *In re Wood* 199 USPQ 137; *In re Lohr* 137 USPQ 548. Thus it would have been obvious to one skilled in the art at the time of the invention was made to

expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Applicants' argument to overcome this rejection with a declaration from Dr. Caldwell is not persuasive.

Applicants have not provided any unexpected/ superior properties to overcome the rejection. The declaration of Dr. Caldwell relates to pyridinyl compounds not to instant pyrimidinyl species. Given the admission on last but one paragraph of the response, which assert obviousness and suggests subtle structural variations can influence activity, there is no basis to believe that what appears to be relevant to pyridinyl compound to be relevant to pyrimidinyl compound absent any comparative data. Hence, the showing of applicants for pyridinyl compound does not commensurate in scope with the subject matter claimed namely the pyrimidinyl species. See *Ex parte Gelles* 22 USPQ 2nd 1318. Note Gelles, especially the following quote: "The evidence relied upon also should be reasonably commensurate in scope with the subject matter claimed and illustrate the claimed subject matter "as a class" relative to prior art subject matter."

See MPEP 716.02(e) which states:

Showing unexpected results over one of two equally close prior art references will not rebut *prima facie* obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984).

Hence the rejection is proper and is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 5,597,919. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the claim 12 is an obvious variant of

the subject matter taught in claim 8 of US 5,597,919 as discussed in the above 103 rejection.

Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-21 of copending Application No. 09/973,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species claimed in claim 12 is also generically claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 08/631,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species claimed in claim 12 is also generically claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Note above application was abandoned at the time the examiner made the previous office action and has been revived after the office action was made. Note examiner had made the obviousness-type double patenting rejection –over 08/631,761 in the copending continuation application 09/522,117. Hence this rejection is necessitated by applicant's action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

References cited in the Supplemental Information Disclosure Statement (paper # 8) are made of record except for the International Search Report, which is not a publication per se and thus is not properly cited as such in the IDS. See MPEP 2205. Applicants should also note that there are no other IDS in the case. Hence the reason for citing the above IDS as supplemental is not clear.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

9/3/2002